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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,120

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Gerald Payne

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT

PAPER NUMBER

3725

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,120	<b>Applicant(s)</b> PAYNE ET AL.	
	<b>Examiner</b> JAMILA WILLIAMS	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-28-08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4-8,10,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,964,513 to Ingram et al (hereinafter Ingram) in view of 6,805,926 to Cote et al (hereinafter Cote) and further in view of Applicant's Admitted Prior Art (hereinafter AAPA).

Ingram discloses a label comprising a substate (32, figure 6,7) having first and second opposing surfaces and first and second sections (34,36), adhesive applied to the second surface of the first section for adhering the label in use to an article (second surface of 34 adhesively attached to the container). Ingram discloses the label having indicia that is concealed when the second section is adhered in a non-viewing position and is revealed when the second section is lifted into a viewing position (figure 6 for example shows label in viewing position, non-viewing position would be when second section 36 is adhered to first section 34).

Ingram does not however disclose having at least one security feature incorporated in or on at least one of the first and second sections.

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Cote teaches having a label on a container with security features (column 3 lines 19-33 of Cote). Cote also teaches having the security feature concealed from view until the label is pulled up or removed from the container (column 3 lines 66-67 and column 4 lines 1-3 of Cote).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the security feature of Cote on the first or second sections of the label of Ingram for the purpose of providing a label that prevents counterfeiting.

Ingram modified by Cote discloses a label having a first and second section and having security features (security thread) associated therewith. This combination does not however clearly disclose that the security thread is viewed differently in transmissive or reflected light.

AAPA teaches on page 2 first paragraph of the specification that security features such as security threads have a different perception in reflected and transmitted light.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teachings of AAPA with the label of Ingram modified by Cote for the purpose of providing a different optical affect when the layer of the label are lifted, as recited in claim 1,3.

Regarding claim 4, Ingram modified by Cote and AAPA discloses at least one security feature located on the first and/or second surfaces of the second

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section (Ingram shows in figure 6, indicia on the second surface 36i of second section 36, Cote provides the teaching of the security feature on the label).

Regarding claim 5, Ingram modified by Cote and AAPA discloses at least one security feature is located on the second surface of the first section (Cote teaches having a security feature on the second surface of the first section of the label- i.e. on the adhesive side of the label, it would have been obvious to use this teaching in the label of Ingram for the purpose of providing a security feature that can be seen through a transparent container for example, see figure 1b of Cote).

Regarding claim 6, Ingram modified by Cote and AAPA discloses the first and second sections hinge about a fold line (Ingram column 4 lines 9-13).

Regarding claim 7, Ingram modified by Cote and AAPA discloses a second repositionable adhesive applied to at least a part of one surface of the second section (column 4 lines 1-4 of Ingram and figure 6 surface 36i).

Regarding claim 8, Ingram modified by Cote and AAPA discloses the repositionable adhesive is applied to the first surface of the second section such that it adheres to the first section in non-viewing position (column 4 lines 1-4 of Ingram).

Regarding claim 10, Ingram modified by Cote and AAPA discloses the security feature is an elongate security element (embedded security thread of Ingram).

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Regarding claim 11, Ingram modified by Cote and AAPA discloses the security element is partially or wholly embedded within the substrate (column 3 lines 54-55 of Ingram).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Cote, in view of AAPA and further in view of 6,379,764 to Pusateri et al (hereinafter Pusateri).

Ingram modified by Cote and AAPA discloses most elements of the claims including having adhesive on the second surface of the second section such that it can be adhered to a container. The use of repositionable adhesive is not however disclosed.

Pusateri teaches having a label with repositionable adhesive (column 1 lines 32-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the repositinable adhesive as taught by Pusateri with the label of Ingram modified by Cote for the purpose of making the label removable.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Cote, in view of AAPA and further in view of 5,284,363 to Gartner et al (hereinafter Gartner).

Ingram modified by Cote and AAPA discloses most elements of the claims but for the substrate having a plurality of second sections, each liftable from non-viewing to viewing position.

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Gartner teaches having a substrate with a plurality of second sections (figures 5a-6 for example).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the second sections of Gartner with the substrate of Ingram modified by Cote for the purpose of providing more information on the substrate.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram in view of Cote in view of AAPA and further in view of 6,948,742 to Buck.

Ingram modified by Cote and AAPA discloses most elements of the claims including having a substrate with first and second label sections. This combination does not however disclose having the second section separable from the first section or that the separation occurs at the foldline by means of a perforation along the foldline.

Buck teaches having a substrate with multiple sections (46,48,50) separable along a foldline by perforations (42,44 and column 4 lines 24-28 of Buck). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the perforations of Buck with the foldline of Ingram modified by Cote for the purpose of allowing for separation of the first and second sections of the substrate.

### ***Response to Arguments***

Applicant's arguments filed 4-28-2008 have been fully considered but they are not persuasive.

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Regarding Applicant's arguments towards Ingram not being a security label, the examiner maintains that Ingram is being used for the structure of the label itself. Cote is added to provide a teaching of a label with security features as claimed. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of references. In re Nomiya 184 USPQ 607 (CCPA 1975). However there is no requirement that a motivation be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one having ordinary skill in the art. In re McLaughlin 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 1969. In this case, both references are labels. Modifying the features of the label of Cotes with the label of Ingram (to make a security label) is an obvious modification.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory



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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. W./  
Examiner, Art Unit 3725

/Derris H Banks/  
Supervisory Patent Examiner, Art  
Unit 3725